



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,360	09/29/2000	Emeric Thibierge	001254	7133

23850 7590 02/12/2003

ARMSTRONG, WESTERMAN & HATTORI, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 02/12/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,360

Applicant(s)

THIBIERGE ET AL.

Examiner

Victor S Chang

Art Unit

1771

SM
13

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-40 is/are pending in the application.
- 4a) Of the above claim(s) 34-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-33 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 14-33 and 40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in claim 14, line 2, the term "panels" appears to be new matter. Applicants have not provided support of "panels" in the Specification, nor does the Examiner find "panels" to be an inherent property of sheets of paper.

Response to Amendment

5. Applicants' argument traversing the restriction requirement is noted. Applicants request that the Examiner provides a prior art reference to support the Office Action. The Examiner reiterates that Applicants' argument is not found persuasive because

depositing adhesive on a transparent or translucent face or substrate is old and well known, as such it does not make contribution over prior art and it is not applicable as a special technical feature (see section 1 of Paper No. 10). Further, previously cited EP 0256731 does teach forming a transparent envelope by depositing adhesive on a transparent or translucent face or substrate (e.g., column 4, lines 52-56).

The requirement is still deemed proper and is therefore made FINAL.

6. Claims 14-33 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner reiterates that the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors (see section 3 of paper No. 10). Examples include:

It appears that the newly amended claim 14 is still replete with vague, indefinite, redundant and confusing terms and phrases: At lines 1-2, it appears that the phrase "two sheets of paper or one folded sheet of paper" is redundant to the phrase "two ... panels". Also, it is not clear to the Examiner what the term "panels" encompasses. Further, at line 5, the newly added recitation "an aesthetic appearance" is vague and indefinite. It is not clear to the Examiner how "an aesthetic appearance" is to be determined, as any particular pattern could be "aesthetic" per personal preference.

Claim 15 clearly lacks structural relations among various elements (e.g., "front face", "back face", "two flaps ... the flap"), the Examiner reiterates that it is virtually

impossible to positively understand the shape of the claimed product (see 2nd paragraph at page 3 of Paper No. 10.

In claims 26 and 27, lines 2-3 in each claim, the terms "light" and "dark" are clearly vague and indefinite.

In claims 30 and 31, line 2 in each claim, the term "transparentizing" is not believed to be good grammar.

In claims 32 and 33, line 2 in each claim, the phrase "beating paper stock to a high degree" is not understood.

7. Claims 14-33 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0256731 either taken individually, or in view of Akridge et al. (US 5687903), substantially for the reasons set forth in section 5 of Paper No. 10, together with the following additional observations.

With respect to Applicant's Response arguing that EP '731 does not mention the type of glue, so that it is not possible to determine whether the glue would be visible (Response, page 6, 5th paragraph), it should be noted that Applicants have not provided any specific adhesive or glue composition in claim 1. Further, it is common knowledge that it is virtually impossible to make the glue line invisible, simply because such invisibility would require an exact match in refractive indices between the glue and the transparent (or translucent) paper, and virtually all the commonly available glues would have refractive indices which are somewhat different from the commonly used transparent (or translucent) sheets of paper.

With respect to Applicants' arguments relating to the process claims 34-39 (Response, page 7), the Examiner would like to point out that process claims 34-39 are non-elected invention, and have not been treated in the previous Office Action.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1771

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
February 6, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~

1700

Daniel Zinker